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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,160	12/01/2003	Lei Wu	ART-00104.P.1.2	4793

24232 7590 03/20/2006

DAVID R PRESTON & ASSOCIATES APC  
12625 HIGH BLUFF DRIVE  
SUITE 205  
SAN DIEGO, CA 92130

EXAMINER

YANG, NELSON C

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/725,160	WU ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Nelson Yang	1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 49-68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/399,299.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment of the specification is acknowledged and has been entered.
2. Applicant's amendment of claims 49, 50, 53-55 is acknowledged and has been entered.
3. Applicant's addition of claims 57-68 is acknowledged and has been entered.
4. Claims 49-68 are currently pending.

### ***Rejections Withdrawn***

5. Applicant's arguments, see p.11, filed January 9, 2006, with respect to the objections to the specification have been fully considered and are persuasive. The objection of the specification has been withdrawn.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 49-68 are rejected under 35 U.S.C. 102(e) as being anticipated by Sucholeiki [US 5,835,329].

With respect to claims 49, 59, Sucholeiki teaches a method comprising a device comprising electromagnets serving as sources are mounted on the base, so that the sources are essentially coplanar with a section through the active region, with the plane in question being

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parallel to the base (column 5, lines 15-25), for manipulating magnetic particles by attracting the particles to each of the active sources, or to a particular source that is activated (column 5, lines 35-45). The sources may be activated via suitable electronic circuits or computer-activated analog sources of currents such that alternation of the sets of sources of the gradients imposes magnetic field gradients in differing orientations (column 6, lines 35-45).

8. With respect to claims 50-52, 60-62, Sucholeiki teaches that the particles are derivatized such that moieties such as polypeptides may be bound (column 9, lines 45-65).

9. With respect to claims 53, 63, Sucholeiki teaches that the device can be used for manipulating magnetic particles by attracting the particles to each of the active sources, or to a particular source that is activated (column 5, lines 35-45), which would be considered magnetophoresis.

10. With respect to claims 54, 64, Sucholeiki teaches a contact switch to alternate the activation of the electromagnet (column 10, example 1).

11. With respect to claims 55, 65, Sucholeiki teaches that the electromagnets include circuits (cores) with terminals (column 10, example 1).

12. With respect to claims 56, 66, Sucholeiki teaches that the device can contain wells (dips) (column 9, lines 65-67).

13. With respect to claim 57, 67, Sucholeiki teaches that a horizontal array (column 3, lines 40-55), with electromagnets mounted on the base of the array (column 5, lines 15-25).

14. With respect to claims 58, 68, Sucholeiki also teaches an embodiment where the electromagnets are mounted substantially vertically (figs. 3, 4).

***Response to Arguments***

15. Applicant's arguments with respect to claims 49-56 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

16. No claims are allowed.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson Yang whose telephone number is (571) 272-0826. The examiner can normally be reached on 8:30-5:00.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (571)272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nelson Yang  
Patent Examiner  
Art Unit 1641

  
CHRISTOPHER L. CHIN  
PRIMARY EXAMINER  
GROUP 1800 1641  
3/15/06